

Attorney Docket No. 9792909-4865 (formerly SONY-P7449)

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Re Patent Application of

Tomoyuki Asano

Application No. **08/865,403**

Filed: **May 29, 1997**

For: **CHARGING SYSTEM AND
CHARGING METHOD**

) **Group Art Unit 2164**
)

) **Examiner: Nga B. Nguyen**
)

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Marina N. Saito

Commissioner for Patents
Washington, D.C. 20231

APPELLANT'S BRIEF ON APPEAL

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 1.192, Appellant herewith submits this
Brief in support of the Appeal for the above-referenced application.

I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is the Assignee, Sony Corporation, a
Japanese Corporation. The Assignment was recorded in the U.S. Patent and Trademark Office at
Reel 8591, Frame 0962.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and no related interferences.

III. STATUS OF CLAIMS

Claims 9, 17-25, 37-46, and 53-62 are pending in this application. Claims 1-8, 10-16, 26-36, and 47-52 have been cancelled. The present Appeal is directed to claims 9, 17-25, 37-46, and 53-62, which were finally rejected under 35 U.S.C. § 102(e) as being anticipated by Sirbu et al., U.S. Patent No. 5,809,144, in an Office Action dated June 6, 2001.

IV. STATUS OF AMENDMENTS

Subsequent to the June 6, 2001, Final Office Action, an Amendment After Final was filed on September 6, 2001. The Amendment After Final proposed an amendment to claim 42. In an Advisory Action mailed on September 27, 2001, the Examiner indicated that the proposed amendment would be entered for purposes of an Appeal. Accordingly, the amendment of claim 42 is considered entered.

V. SUMMARY OF INVENTION

This application relates to a charging system and a charging method for an electronic commerce system. (Page 1, lines 4-5). For example, in a service providing system and method, a user sends a service request and a digital signature to a service provider. (Page 4, line 19- page 5, line 4). The digital signature is generated based on the service request from a user terminal. (Page 5, lines 5-7). The service provider checks whether the digital signature data received from the user is valid. (Page 5, lines 16-17). If the service provider determines that the digital signature data is valid, the service provider provides the service to the user terminal. (Page 5, line 22 – page 6, line 2). The service provider then requests that a bank collect the fee from the user. (Page 6, lines 6-9). The bank informs the user that the fee is to be collected.

(Page 6, lines 9-10). If the user does not accept the amount of the fee, the user may request that the service provider disclose the service request data and digital signature data. (Page 6, lines 11-17). As a result, the service provider discloses the service request data and digital signature to the bank. (Page 6, lines 18-20). The bank checks the validity of the service request data and digital signature data, calculates a proper fee based upon them, collects the fee from the user, and pays it to the service provider. (Page 6, line 21-page 7, line 1). Thus, the user is protected from having the service provider charge a wrong fee, and the service provider is able to prove that it is charging a proper fee. (Page 2, lines 15-17).

VI. ISSUES

The issue on Appeal is as follows:

Whether claims 9, 17-25, 37-46, and 53-62 are anticipated by Sirbu et al. under the provisions of 35 U.S.C. § 102(e).

VII. GROUPING OF CLAIMS

Based on the rejection set forth by the Examiner, claims 9, 17-25, 37-46, and 53-62 stand or fall together. Appellant, however, reserves the right to pursue the dependent claims separately in any continuation application.

VIII. ARGUMENT

Claims 9, 17-25, 37-46, and 53-62 are not anticipated by Sirbu et al. under 35 U.S.C. § 102(e).

A. The Claimed Invention

Claim 9 claims a method for providing a service to a user. The method comprises the steps of receiving a service request requesting desired service for the user from a service provider and a digital signature generated based on the service request from a user terminal, providing the service to the user terminal according to the service request, requesting a charge collection from an accounting terminal based on the service request, and providing the service request and the digital signature to the accounting terminal when a disclosure request of service requests and digital signatures is received.

Claim 23 claims the method of claim 9 wherein the disclosure requests of the service requests and digital signatures is received from the user.

Claim 37 claims a system for providing a service to a user. The system comprises means for receiving a service request requesting desired service for the user from a service provider and a digital signature generated based on said service request from a user terminal, means for providing the service to the user terminal according to said service request, means for requesting a charge collection from an accounting terminal based on said service request, and means for providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.

Claim 44 claims the system of claim 37 wherein the disclosure requests of the service requests and digital signatures is received from the user.

Claim 53 claims a system for providing a service to a user. The system comprises a service provider for receiving from a user terminal a service request requesting desired service for the user and a digital signature generated based on said service request, wherein the service provider, provides the service to the user terminal according to said service request, requests a charge collection from an accounting terminal based on said service request, and provides said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.

Claim 60 claims the system of claim 53 wherein the disclosure requests of the service requests and digital signatures is received from the user.

Because claims 17-22 and 24-25 ultimately depend on claim 9, they include all of the limitations of claim 9. Because claims 38-43 and 45-46 ultimately depend on claim 37, they include all of the limitations of claim 37. Because claims 54-59 and 61-62 ultimately depend on claim 53, they include all of the limitations of claim 53.

B. The Rejection

In the Final Office Action, claims 9, 17-25, 37-46, and 53-62 were rejected under 35 U.S.C. § 102(e) as being anticipated by Sirbu et al. In response, Appellant noted that Sirbu et al. neither discloses nor suggests providing a service request to the account server. Appellant also noted that Sirbu et al. does not disclose or suggest a disclosure request for the service requests and digital signatures. In the Advisory Action, the Examiner cited to column 5, line 44 through column 6, line 37, for support that the account server receives and verifies a digitally signed electronic payment order that includes customer's digital signature.

C. Claims 9, 17-25, 37-46, and 53-62 Are Not Anticipated by Sirbu et al.

The Examiner has not made an adequate showing that claims 9, 17-25, 37-46, and 53-62 are anticipated by Sirbu et al. under 35 U.S.C. § 102(e).

In the Advisory Action, the Examiner failed to address Appellant's arguments set forth in Appellant's Amendment After Final. In particular, claims 9, 37 and 53 require the method or system to provide a service request and a digital signature to the accounting terminal when a disclosure request of service requests and digital signatures is received. Contrary to claims 9, 37 and 53, Sirbu et al. neither discloses nor suggests providing a service request to the account server when a disclosure request is received.

In the Advisory Action, the Examiner specifically disagreed with Appellant's statement that Sirbu et al. does not disclose service requests to the account server when a digitally signed electronic payment order is sent and cited to column 5, line 44 through column 6, line 37 in Sirbu et al. for support. The Examiner then stated that in Sirbu et al., "the account server receives and verifies a digitally signed electronic payment order included customer's digital signature." This statement, however, only addresses providing a digital signature to the account server and does not address providing service requests to the account server. In addition, the text cited to by the Examiner discloses that a countersigned EPO is sent to the account server. Sirbu et al. states that the countersigned EPO may include customer identity, product identifier, negotiated price, merchant identifier, the second cryptographic checksum, the EPOID (electronic payment order ID) containing the timestamp, a digital signature, the merchant's account number, a merchant memo field, an electronic signature, and the key needed to decrypt the good. (See column 5, line 63 through column 6, line 2 and column 6, lines 13-17.) Sirbu et al., however, does not include a service request as part of the countersigned EPO.

As also stated in the Amendment After Final, Sirbu et al. does not disclose or suggest that the service provider receives a disclosure request for the service requests and digital signatures. The Examiner did not dispute this statement in the Advisory Action.


Finally, as stated in the Amendment After Final, claims 23, 44 and 60 further require that the disclosure requests of the service requests and digital signatures is received from the user, which is neither disclosed nor suggested by Sirbu et al. The Examiner also failed to dispute this statement in the Advisory Action.

D. Conclusion

Appellant respectfully submits that the subject matter of the claims on appeal is not found or suggested by Sirbu et al. Thus, the Examiner has not made an adequate showing of anticipation or obviousness with respect to the subject matter of the rejected claims. Appellant, therefore, respectfully requests reversal of the Examiner's decision to reject claims 9, 17-25, 37-46, and 53-62 under 35 U.S.C. § 102(e) as being anticipated by Sirbu et al., and respectfully requests allowance of all claims.

Respectfully submitted,

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IX. APPENDIX

9. A method for providing a service to a user, comprising the steps of:

receiving a service request requesting desired service for the user from a service provider and a digital signature generated based on said service request from a user terminal;

providing the service to the user terminal according to said service request;

requesting a charge collection from an accounting terminal based on said service request;

and

providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.

17. The method according to claim 9, wherein said digital signature is generated only by said user.

18. The method according to claim 9, wherein

said service provider verifies said digital signature received from said user terminal, and

said service provider provides the service to the user if said digital signature is valid.

19. The method according to claim 9, wherein

said service provider verifies said digital signature received from said user terminal, and

said service provider rejects the service request from the user terminal if the user falls behind in his payment.

20. The method according to claim 9, wherein
said service request from the user terminal includes a user name, bank account information, a name of service provider, a name of the service to be provided, date and time.

21. The method according to claim 9, wherein
said charge collection request to said accounting terminal includes a user name, a bank account information and amount of fee.

22. The method according to claim 9, wherein
said charge collection request to said accounting terminal includes said service request and said digital signature received from the user terminal.

23. The method according to claim 9, wherein
said disclosure requests of said service requests and digital signatures is received from the user.

24. The method according to claim 9, wherein
said service provider charges a fee to the user based on a time period said service is provided to the user.

25. The method according to claim 9, wherein
said service provider charges a fee to the user based on contents provided to the user.

37. A system for providing a service to a user, comprising:

means for receiving a service request requesting desired service for the user from a service provider and a digital signature generated based on said service request from a user terminal;

means for providing the service to the user terminal according to said service request;

means for requesting a charge collection from an accounting terminal based on said service request; and

means for providing said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.

38. The system according to claim 37, wherein said digital signature is generated only by said user.

39. The system according to claim 37, wherein

said service provider verifies said digital signature received from said user terminal, and

said service provider provides the service to the user if said digital signature is valid.

40. The system according to claim 37, wherein

said service provider verifies said digital signature received from said user terminal, and

said service provider rejects the service request from the user terminal if the user falls behind in his payment.

41. The system according to claim 37, wherein
said service request from the user terminal includes a user name, bank account information, a name of service provider, a name of the service to be provided, date and time.

42. The system according to claim 37, wherein
said charge collection request to said accounting terminal includes a user name, a bank account information and amount of fee.

43. The system according to claim 37, wherein
said charge collection request to said accounting terminal includes said service request and said digital signature received from the user terminal.

44. The system according to claim 37, wherein
said disclosure requests of said service requests and digital signatures is received from the user.

46. The system according to claim 37, wherein
said service provider charges a fee to the user based on contents provided to the users.

53. A system for providing a service to a user, comprising:

a service provider for receiving from a user terminal a service request requesting desired service for the user and a digital signature generated based on said service request, wherein the service provider

provides the service to the user terminal according to said service request,

requests a charge collection from an accounting terminal based on said service request,

and

provides said service request and said digital signature to said accounting terminal when a disclosure request of service requests and digital signatures is received.

54. The system according to claim 53, wherein said digital signature is generated only by said user.

55. The system according to claim 53, wherein
said service provider verifies said digital signature received from said user terminal, and
said service provider provides the service to the user if said digital signature is valid.

56. The system according to claim 53, wherein
said service provider verifies said digital signature received from said user terminal, and
said service provider rejects the service request from the user terminal if the user falls behind in his payment.

57. The system according to claim 53, wherein
said service request from the user terminal includes a user name, bank account information, a name of service provider, a name of the service to be provided, date and time.

58. The system according to claim 53, wherein
said charge collection request to said accounting terminal includes a user name, a bank account information and amount of fee.

59. The system according to claim 53, wherein
said charge collection request to said accounting terminal includes said service request and said digital signature received from the user terminal.

60. The system according to claim 53, wherein
said disclosure requests of said service requests and digital signatures is received from the user.

61. The system according to claim 53, wherein
said service provider charges a fee to the user based on a time period said service is provided to the user.

62. The system according to claim 53, wherein
said service provider charges a fee to the user based on contents provided to the user.